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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application: Peter R. Fenner

Application No.: 09/227,688

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Group Art Unit: 2662

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Examiner: Hanh Nguyen

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Docket No.: 3797.1-8

Technology Center 2600

For: Method and Apparatus for Use of Associated Memory with
Large Key Spaces

BOX APPEAL BRIEF
Director of the United States
Patent and Trademark Office
Washington, D.C. 20231

APPELLANT'S BRIEF IN SUPPORT OF APPEAL

This Brief is in furtherance of the Notice of Appeal, mailed in this case on June 25, 2001, and filed on June 27, 2001. An Amendment After Final is being concurrently filed.

This Brief is transmitted in triplicate.

This Brief contains these items under the following headings, and in the order set forth below (37 C.F.R. § 1.192(c)):

- I. Real Party In Interest
- II. Related Appeals and Interferences

III. Status of Claims

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B. Claims on Appeal

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V. Summary of Invention

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A. It was error for the Examiner to refuse to recognize Appellant's claim of priority with regard to claims 19-28 and 32-40

B. The rejection of claims 19-23 under 35 U.S.C. §112, second paragraph was in error

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X. Appendix of claims involved in the appeal

The final page of this Brief bears the attorney's signature.

I. REAL PARTY IN INTEREST

The real party in interest in this appeal is:

4 Eagle Magic, LLC

II. RELATED APPEALS AND INTERFERENCES

There are no other appeals or interferences that will directly affect, or be directly affected by, or have a bearing on the Board's decision in this appeal.

III. STATUS OF CLAIMS

A. STATUS OF ALL THE CLAIMS

1. Claims 1-18 and 29-31 have been canceled.
2. Claims 19-28 and 32-40 are pending in the application.
3. No claims have been allowed.
4. Claims 19-28 and 32-40 have been rejected.

B. CLAIMS ON APPEAL

Claims 19-28 and 32-40 are on appeal.

IV. STATUS OF AMENDMENTS

An Amendment After Final was filed pursuant to 37 C.F.R. §1.116(b) on June 11, 2001.

The Amendment After Final canceled claims 29-31 and amended claim 27 by deleting the word "public" in line 3. The Examiner responded to that Amendment in an Advisory Action dated June 18, 2001 indicating that the cancellation of the claims has been entered. In the Advisory

Action, the Examiner did not indicate that the proposed amendment to claim 27 would be entered. An Amendment After Final pursuant to 37 C.F.R. §1.116(b) is being concurrently filed correcting typographical errors in claims 22, 25, 33, 35, and 36.

The currently pending claims including claim 27 as amended by the Amendment After Final, filed on June 11, 2001, are enclosed herein at Section X. The claims in Section X do not reflect the amendments made to claims 22, 25, 33, 35, and 36 by the Amendment After Final filed on August 23, 2001.

V. SUMMARY OF INVENTION

The present invention generally pertains to a communication system for routing data packets to a mobile receiver (for example, ship 12 of FIGURE 1) through two or more networks (for example, networks 1 and 5 of FIGURE 1) interconnected by one or more message handling nodes (for example, nodes 16, 20, 24, 26, 30 and 32 of FIGURE 1). Each data packet includes a logical destination code, such as an Internet Protocol (IP) address, for identifying the receiver independently of a physical medium over which the data packet is routed. The logical destination code uniquely identifies the receiver to each of the networks. The logical destination code does not change as the mobile receiver changes networks. Each data packet may also include a logical source code, such as an Internet IP address, for identifying the source independently of the physical medium over which the data packet is routed. The logical source code uniquely identifies the source to each of the networks and does not change when the source connects to a node in a different network. Based on the destination code, the data packets are routed by the message handling nodes to the mobile receiver, wherever the mobile receiver may

be located within the two or more interconnected networks. *See, e.g.*, page 25, line 1 through page 29, line 20 and page 32, line 3 through page 33, line 17.

VI. ISSUES

1. Was it error for the Examiner to refuse to recognize Appellant's claim of priority with regard to claims 19-28 and 32-40?
2. Is the rejection of claims 19-23 under 35 U.S.C. §112, second paragraph in error?

VII. GROUPING OF CLAIMS

For purposes of this appeal brief only, claims 19-28 and 32-40 have been grouped as Group I and claims 19-23 have been grouped as Group II.

VIII. ARGUMENTS

A. It was error for the examiner to refuse to recognize appellant's claim of priority with regard to claims 19-28 and 32-40

Claims 19-22, 24, 25, 27, 32, 33, 35, 36, 38 and 39 of Group I have been rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 5,365,520 to Wang et al. ("Wang"). Claims 23, 26, 28, 34, 37, and 40 of Group I have been rejected under 35 U.S.C. §103(a) as being unpatentable over Wang. Appellant has asserted priority to June 16, 1989, well before Wang's filing date of March 27, 1992. Despite identifying the portions of the present application that were pending in the priority application, the Examiner has refused to recognize the claim for the sole reason that the present application is a continuation-in-part of the priority application. This is clear error.

Section 120 of Title 35 of the United State Code plainly does not limit the right to claim priority only to continuation applications. *See* 35 U.S.C. §120 (2000). The Court of Appeals for the Federal Circuit confirmed that a continuation-in-part application is entitled to the benefits of section 120 of Title 35 in *Waldemar Link, GmbH & Co. v. Osteonics Corp.*, 32 F.3d 556, 31 U.S.P.Q. 2d 1855, 1857 (Fed. Cir. 1994). With reference to continuation-in-part applications, the Court stated that matter disclosed in a continuation application that is also disclosed in a parent application is entitled to the benefit of the filing date of the parent application. *Id.* According to the Federal Circuit, “[t]he bottom line is that, no matter what term is used to describe a continuing application, that application is entitled to the benefit of the filing date of an earlier application . . . as to common subject matter”. *Transco Prods. Inc. v. Performance Contracting*, 38 F.3d 551, 32 U.S.P.Q. 2d 1077, 1080 (Fed. Cir. 1994), *cert. Denied*, 513 U.S. 1151 (1995).

It is further well settled that “[a] claim in a CIP application is entitled to the filing date of the parent application when the claimed invention is described in the parent specification in a manner that satisfies, *inter alia*, the description requirement of 35 U.S.C. Section 112.” *Therma-Tru Corp. v. Peachtree Doors Inc.*, 44 F.3d 988, 33 U.S.P.Q. 2d 1274, 1276 (Fed. Cir. 1995) (citing *Kennecott Corp. v. Kyocera Int'l, Inc.*, 835 F.2d 1419, 1421, 5 U.S.P.Q. 2d 1194, 1196-97 (Fed. Cir. 1987), *cert. denied*, 486 U.S. 1008 (1988). The Examiner has not rejected any of the claims under 35 U.S.C. §112, paragraph 1.

Appellant has complied with the statutory requirements under 35 U.S.C. §120, the requirements under 37 C.F.R. §1.78(a) and the requirements of M.P.E.P. §201.11. As stated in M.P.E.P. §201.11, these requirements are:

- (A) the second application must contain a specific reference to the prior application(s) in the specification,

- (B) the second application must be copending with the first application or with an application similarly entitled to the benefit of the filing date of the first application,
- (C) the second application must be filed by an inventor or inventors named in the previously filed application, and
- (D) the second application must be an application for a patent for an invention which is also disclosed in the first application; the disclosure of the invention in the first application and in the second application must be sufficient to comply with the requirements of the first paragraph of 35 U.S.C. 112.

The Preliminary Amendment of January 8, 1999 amended the specification of the present application such that the first sentence of the specification contained a reference to the application from which priority was being claimed including the intervening applications. The priority claim of the present application reads: "This application is a continuation of U.S. application no. 08/174,361, filed December 28, 1993, which is a continuation-in-part of U.S. application 07/952,988, filed on September 29, 1992, now U.S. patent no. 5,490,258, which is a continuation-in-part of U.S. application 07/737,147, filed July 29, 1991, now abandoned, which is a continuation-in-part of U.S. application 07/367,012, now U.S. patent no. 5,095,480."

Although the present application was not co-pending with U.S. Patent No. 5,095,480 (the "480 patent"), it was co-pending with at least one application entitled to the benefit of the filing date of the application that was issued as the '480 patent thereby satisfying the copendency requirement.

Finally, Mr. Peter R. Fenner, the named inventor in the present application, is also a named inventor in the '480 patent and in each of the intervening applications from which priority is claimed. Therefore, Appellant has perfected a claim of priority to June 16, 1989.

In an Office Action dated July 18, 2000, the Examiner rejected some of the claims of the present application under 35 U.S.C. §102(b) as being anticipated by *Wang*, and the remaining claims under 35 U.S.C. §103(a) as being unpatentable over *Wang*. *Wang* has a filing date of March 27, 1992 almost three years later than the priority date of the present application.

In a response to the Office Action filed on December 27, 2000, Appellant pointed out to the Examiner that the present application claims priority to June 16, 1989, and that *Wang* does not qualify as a prior art reference under 35 U.S.C. §102. In the response Appellant also generally noted the portions of the '480 patent and the corresponding portions of the specification of the present application that supported the claims of the present application, for example, FIGURES 1-4; column 8, lines 6-68 (p. 25, line 1 to p.27, line 12); column 9, lines 1-59 (p. 27, line 12 to p.28, line 17); and column 17, lines 31-50 (p. 49, line 1 to p. 50, line 12).

In a Final Office Action dated March 12, 2001, the Examiner maintained his rejection of the claims under 35 U.S.C. §102(b) and 35 U.S.C. §103(a). The Examiner further noted that Appellant's "arguments filed on 12/27/2000, have been fully considered but they are not persuasive." The only reasoning provided by the Examiner for finding Appellant's arguments not persuasive was:

Applicant claims priority on CIP back to June 16, 1989 which is the filing date of the application maturing in US Patent No. 5,095,480. Examiner respectfully disagrees because the applicant does not filed continuation [sic]. Therefore, applicant is required to supply evidence of the continuation back to June 16, 1989 in order to claim priority on the application.

An Examiner is to assume that the claims of a CIP application are entitled to the filing date of the parent application(s) under the provisions of 35 U.S.C. §120 unless there is a need to actually determine such entitlement due to the presence of an intervening reference. *Ex parte Erlich*, 3 U.S.P.Q. 2d 1011, 1013 (Bd. Pat. App. & Inter. 1987). The “examiner has the initial burden of presenting evidence or reasons why persons skilled in the art would not recognize in an applicant’s disclosure a description of the invention defined by the claims.” *See*, M.P.E.P. §2163.04, *citing In re Wertheim*, 541 F.2d 257, 265, 191 U.S.P.Q. 90, 98 (C.C.P.A. 1976). *See also*, *Ex parte Sorenson*, 3 U.S.P.Q. 2d 1462, 1463 (Bd. Pat. App. & Inter. 1987). Any time an examiner bases a rejection of a claim or the denial of the effect of a filing date of a previously filed application on the lack of a written description, the examiner must: (A) identify the claim limitation not described; and (B) provide reasons why persons skilled in the art at the time the application was filed would not have recognized the description of this limitation in the disclosure of the application as filed. In the present case, the Examiner has failed to do so. At no point during the prosecution of the present application were the claims currently on appeal rejected under 35 U.S.C. §112, first paragraph.

Accordingly, Appellant has complied with the statutory requirements under 35 U.S.C. §120, the requirements under 37 C.F.R. 1.78(a) and the requirements as set out in M.P.E.P. §201.11. The mere fact that the claim of priority includes several continuations-in-part applications does not defeat an otherwise proper claim of priority. It was error for the Examiner to refuse to recognize Appellant’s claim of priority with regard to claims 19-28 and 32-40. As the priority date is more than two years prior to *Wang*’s filing date, *Wang* cannot be prior art under 35 U.S.C. §102. Thus, the rejections of the claims of Group I is in error and must be reversed.

B. The rejection of claims 19-23 under 35 U.S.C. §112, second paragraph was in error

The rejection of claims 19-23 of Group I under 35 U.S.C. §112, second paragraph is in error. In the Office Action mailed March 12, 2001, the Examiner states that it is not clear if "identifying the receiver" refers to the "mobile receiver" on line 2 or "any receiver". Claims 20-23 are rejected because they depend on claim 19.

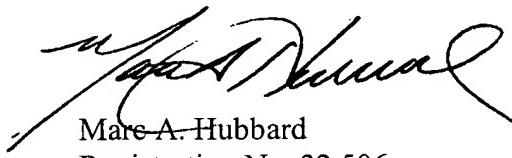
"[T]he receiver" plainly refers to the receiver identified in line 3 of claim 19. The article "the" used before "receiver" unambiguously means that it must be the receiver that has already been introduced. Only one receiver is introduced in claim 19. The word "mobile" is an adjective modifying the element "receiver". The absence of the word "mobile" in front of "receiver" in claim 19 does not create any ambiguity. Claim 19, without question, meets the requirements of 35 U.S.C. §112, second paragraph.

As such Appellant submits that the rejection of claims 19-23 under 35 U.S.C. §112, second paragraph was in error.

IX. CONCLUSION

For the reasons stated above, Appellant submits that the rejection of the pending claims is in error, and that the final rejection of the claims of the application be reversed.

Respectfully submitted,



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X. APPENDIX OF CLAIMS

The claims involved in the appeal are:

19. A communication system of interconnected networks, the system comprising:

a mobile receiver; and

two or more networks interconnected by at least one message handling node for routing data packets;

wherein, each of the data packets includes a logical destination code for identifying the receiver independently of a physical media address in each of the data packets, the logical destination code uniquely identifying the mobile receiver to each of the networks and remaining fixed as the mobile receiver changes networks; and

wherein, each message handling node routes data packets to the mobile receiver based on the destination code, wherever the mobile receiver is located within the two or more interconnected networks.

20. The communication system of Claim 19, wherein each message handling node stores a table for looking up physical media routing information based on the logical destination code.

21. The communication system of Claim 19 wherein each messaging handling node routes the data packet based on the entire destination code.

22. The communication system of Claim 19 wherein the logic destination code is a globally unique identifier.

23. The communication system of Claim 22 wherein the logical destination code is an Internet Protocol (IP) address.

24. In a communications node of a system, a method for routing data packets comprising:

receiving a first data packet, the data packet including a unique logical code for identifying a mobile source of the data packet independently of the physical media over which the mobile source is communicating;

storing the logical code and associating it with the physical media path from which the first data packet was received;

receiving a second data packet, the second data packet including the logical code as identifying the mobile source as a destination of the second data packet;

looking up the physical media path associated with the logical code; and
forwarding the second data packet based on the stored physical media path.

25. The method of Claim 24 wherein the logic code uniquely identifies the mobile source for routing data packets within public; interconnected networks.

26. The method of Claim 25 wherein the logical code is an Internet Protocol (IP) address.

27. In a communications node of a system of interconnected networks, a method for routing data packets comprising:

storing a unique address for identifying a mobile receiver of a data packet anywhere within interconnected networks, independently of the physical media over which the mobile receiver is communicating;

associating the unique address with a physical media path;

receiving a data packet identifying the mobile receiver as a destination for the data packet by the unique address;

looking up the physical media path along which to forward the data packet using the entire unique address contained in the data packet; and

forwarding the data packet according to the physical media path.

28. The method of Claim 27 wherein the logical code is an Internet Protocol (IP) address.

32. A communications node for routing data packets, each such data packet including a logical code for uniquely identifying a mobile source of each such data packet independently of the physical media over which the mobile source is communicating with the interconnected networks, the communications node including a packet routing device and data structure stored in a memory for associating a logical code of a first data packet sent by a mobile source with a physical media path identifier identifying the physical media path from which the first data packet was received; wherein, when the communications node receives a second data packet that

includes the logical code as identifying the mobile source as a destination of the second data packet, the packet routing device looks up in the data structure the physical media path identifier associated with the logical code and forwards the second data packet to the physical media path identified by the physical media path identifier.

33. The communication system of Claim 32 wherein the logic code is a globally unique identifier.

34. The communication system of Claim 33 wherein the logical code is an Internet Protocol (IP) address.

35. A communications node for routing data packets, each such data packet including a logical code for uniquely identifying a source of each such data packet independently of the physical media over which the source is communicating with the interconnected networks, the communications node including a packet routing device and a data structure stored in a memory for storing the logical code of a first data packet sent by a mobile source and associating it with a physical media path identifier to which the first data packet was forwarded by the communications node; wherein, when the communications node receives a second data packet, which includes the logical code as identifying the source, the packet routing device looks up in the data structure the physical media path identifier of the node associated with the logic code and forwards the second data packet to the node.

36. The communication system of Claim 35 wherein the logic code is a globally unique identifier.

37. The communication system of Claim 36 wherein the logical code is an Internet Protocol (IP) address.

38. A communications node for connecting a plurality of networks comprising a packet routing device and a data structure for storing a logical address that uniquely identifies a host within the plurality of networks independently of physical media on which the host is communicating, the data structure associating the logical address with routing information for forwarding data packets containing the logical addresses; wherein the packet routing device includes a circuit for looking up routing information in the data structure for forwarding the data packet to the host using the entire logical address contained in the data packet.

39. The communications network of Claim 38, wherein the circuit for looking up includes a circuit for determining an index into the table.

40. The communications network of Claim 39, wherein the circuit for determining includes a device for arithmetically compressing the entire logical address.